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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/811,909   | 03/30/2004  | Tetsuya Kunisawa     | 1403-0264PUS1       | 3192             |
| 2292   | 7590        | 03/22/2006           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      |                     | MULCAHY, PETER D |
|  |             | ART UNIT             |                     | PAPER NUMBER     |
|  |             |                      |                     | 1713             |

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                              |                  |  |
|---|------------------------------|------------------|--|
| <b>Office Action Summary</b>  | Application No.              | Applicant(s)     |  |
|   | 10/811,909                   | KUNISAWA ET AL.  |  |
|   | Examiner<br>Peter D. Mulcahy | Art Unit<br>1713 |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>  |                              |                  |  |
| <b>Period for Reply</b>   |                              |                  |  |
| <b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</b>  |                              |                  |  |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                              |                  |  |
| <b>Status</b>   |                              |                  |  |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>30 March 2004</u> .   |                              |                  |  |
| 2a) <input type="checkbox"/> This action is <b>FINAL</b> .                            2b) <input checked="" type="checkbox"/> This action is non-final.   |                              |                  |  |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.   |                              |                  |  |
| <b>Disposition of Claims</b>  |                              |                  |  |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1-3</u> is/are pending in the application.   |                              |                  |  |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration.  |                              |                  |  |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed.  |                              |                  |  |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1-3</u> is/are rejected.   |                              |                  |  |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to.  |                              |                  |  |
| 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.  |                              |                  |  |
| <b>Application Papers</b>   |                              |                  |  |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.   |                              |                  |  |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.   |                              |                  |  |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).   |                              |                  |  |
| Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  |                              |                  |  |
| 11) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.   |                              |                  |  |
| <b>Priority under 35 U.S.C. § 119</b>   |                              |                  |  |
| 12) <input checked="" type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).   |                              |                  |  |
| a) <input checked="" type="checkbox"/> All    b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:   |                              |                  |  |
| 1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received.   |                              |                  |  |
| 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.   |                              |                  |  |
| 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  |                              |                  |  |
| * See the attached detailed Office action for a list of the certified copies not received.  |                              |                  |  |
| <b>Attachment(s)</b>  |                              |                  |  |
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   |                              |                  |  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  |                              |                  |  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/26/04&amp;3/30/04</u> .   |                              |                  |  |
| 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____.  |                              |                  |  |
| 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)   |                              |                  |  |
| 6) <input type="checkbox"/> Other: _____.   |                              |                  |  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsunoda et al. US 6,300,396.
3. The cited patent shows rubber compositions having incorporated therein the claimed polyethylene powders see column 3 lines 20-25. The incorporation of the claimed filler is shown in the examples (carbon black). In view of this disclosure the claims are not novel.
4. Claim1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 3021801.
5. The cited abstract shows rubber compositions having incorporated therein the claimed polyethylene powders. The abstract teaches the use of the rubber in tire applications. These necessarily involve fillers. In view of this disclosure the claims are not novel.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masson et al. US 3,842,883.

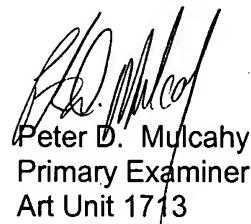
9. This patent shows tires formulated from rubber compositions having incorporated therein polyethylene powders. The difference between the claimed invention and that of the art is the claimed particle size is not expressly stated. The art is generic to the claimed particle size and identifies the powder as being "fine". This is further seen to direct one the particle size claimed. As such, it is obvious to select powders having the claimed size.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter D. Mulcahy  
Primary Examiner  
Art Unit 1713

3/18/06